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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,731	07/25/2003	Shinpei Okajima	SN-US035079	9684
22919	7590	08/06/2004	EXAMINER	
SHINJYU GLOBAL IP COUNSELORS, LLP 1233 20TH STREET, NW, SUITE 700 WASHINGTON, DC 20036-2680			BELLINGER, JASON R	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)
	10/626,731	OKAJIMA, SHINPEI
	Examiner Jason R Bellinger	Art Unit 3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 and 19-33 is/are rejected.
- 7) Claim(s) 17 and 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/22/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Election/Restrictions

1. Applicant's election without traverse of species I, drawn to figures 1-8 and 10-12, in the reply filed on 1 July 2004 is acknowledged.

2. Claim 10 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1 July 2004.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 11, 13-16, 19-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry in view of Dixon et al. Terry shows a bicycle rim H having an annular tire attachment portion for mounting a tire I thereon, and an annular spoke attachment portion fixedly coupled with the tire attachment portion. The spoke attachment portion includes a plurality of circumferential spaced attachment openings. A plurality of reinforcement members F is fixedly coupled to the spoke attachment portion at the attachment openings to effectively increase the thickness of the spoke attachment portion. Each of the trough openings is substantially coincident with a

respective attachment opening when viewed from the central axis of the attachment opening.

Each reinforcement member F has a maximum overlapping dimension that overlaps the annular spoke attachment portion as measured from an outer peripheral edge to a respective attachment opening. The maximum overlapping dimension is at least half as large as a maximum transverse dimension of the attachment openings. Each reinforcement member F includes a rim-facing surface that is in contact with an outer surface of the spoke attachment portion of the rim H, an exterior-facing surface facing in the opposite direction from the rim-facing surface, and a through opening extending between the rim-facing and exterior-facing surfaces that is aligned with an attachment opening.

Each reinforcement member F includes a tubular section f extending through the attachment opening. Each reinforcement member F is elongated in the circumferential direction of the rim H. The rim-facing surface of the reinforcement members F has a contour that corresponds to the contour of the outer surface of the spoke attachment portion. Each reinforcement member F has a symmetrical shape relative to a center plane of the rim H and to a center radial plane that is perpendicular to the center plane of the rim H. the overall circumferential dimension of the reinforcement member F is at least as large as the overall axial dimension thereof.

Terry does not show the spoke attachment portion including a pair of annular side sections and an inner annular section to form a substantially U-shaped cross-sectional shape with an annular hollow area.

Dixon et al teaches the use of a rim 1 having a spoke attachment portion with a pair of annular side portions and an inner annular section that forms a generally U-shaped cross-sectional shape with an annular hollow area. The spoke attachment portion has a substantially uniform radial thickness. The central axes of the attachment openings extend in a substantially radial direction of the rim 1. The tire attachment portion includes an annular bridge section that extends between a pair of annular tire support sections to form a substantially U-shaped cross-section. The annular side sections and inner annular section of the spoke attachment portion, and the tire support section and bridge section are all formed integrally together as a one-piece unitary member. Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the rim of Terry with the shape as taught by Dixon et al for the purpose of allowing a pneumatic tire to be mounted on the rim.

Terry as modified by Dixon et al does not show the reinforcement members being welded or brazed to the spoke attachment portion of the rim around an outer periphery of the reinforcement member. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to weld or braze (dependent upon the material from which the rim and reinforcement members are made) the reinforcement

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members to the spoke attachment portion of the rim for the purpose of providing a permanent reinforcement at the spoke mounting areas, and to reduce the number of parts required to assemble the wheel.

Terry as modified by Dixon et al does not show the tubular section of the reinforcement member and the attachment openings of the rim having internal threads formed therein. Terry does show an additional insert E having internal threads e for securing the spokes D. Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the internal threads in the tubular section and attachment portion without including the additional insert E, for the purpose of reducing the number of parts required to attach the spokes to the rim.

5. Claims 18 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry in view of Dixon et al as applied to claims 1-7, 14-17, 23-25, and 32-35 above, and in further view of Lacombe et al. Terry as modified by Dixon et al does not show the annular bridge section of the rim being free of openings except for a single valve aperture. Lacombe et al teaches the use of a bicycle rim having an annular bridge section devoid of any openings except for a valve opening. Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the bridge section of the rim of Terry as modified by Dixon et al for the purpose of providing an airtight and easily sealable rim.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 4, 6, 11, and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 7 and 17, and 18, respectively, of copending Application No. 10/430,396. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims contain all of the limitations of the co-pending claims in broader and different terms. It is therefore obvious that the Applicant is claiming the same invention. See *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

8. Claims 17-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered to show bicycle rims having reinforcing elements at the spoke mounting holes. For example, Starley shows a rim of the type described above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R Bellinger whose telephone number is 703-308-6298. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason R Bellinger
Examiner
Art Unit 3617


jrb



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